

## REMARKS

### Claim Status

Claims 11-23 are pending in the present application after entry of the present amendment. Applicant has cancelled Claims 29-42, thereby rendering the rejection of these claims moot. Claims 11-23 are rejected for the reasons discussed below, but are thought to be allowable over the cited art.

### Objections to the Specification

The specification is objected to as failing to provide proper antecedent basis for the subject matter of Claims 29 and 38. Claims 29 and 38 are cancelled. Therefore, this objection is moot.

### Rejections Under 35 USC §112, second paragraph

Claims 29-42 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 29-42 are cancelled. Therefore, this rejection is moot.

The Office Action further states:

In claims 11 and 29, it is unclear what phrase "by the vendor" in line 5 modifies. For prior art purposes and in accordance with the precepts of English grammar, the Examiner interprets the phrase "by the vendor" as modifying "configuration".

Applicant has amended Claim 11 to specify that the storing is being performed by the vendor. It is unclear as to whether or not Claim 11 is rejected under 35 USC §112, second paragraph. However, any such rejection should now be overcome.

### Rejections Under 35 USC §103(a)

Claims 11-23 are rejected as being unpatentable over Yuen (U.S. Patent No. 5,367,187) in view of Greene's Production and Inventory Control Handbook, 3rd Ed., ("Greene") and Dobler's Purchasing and Supply Management, Text & Cases, 6th Ed. ("Dobler"). Applicant respectfully traverses this rejection.

Applicant first notes that Dobler includes approximately 961 pages of material. Greene includes approximately 282 pages of material. Yet the Office Action makes only generalized comments about the nature of these references, and does not specify in any way a location in either reference that can be used to substantiate the rejection. 37 CFR 1.104(c)(2) states:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

However, the Office Action makes no attempt to identify within over 1200 pages of material the "particular part(s) relied on" in the rejection. Therefore, the Office Action does not comply with 37 CFR 1.104(c)(2) with regard to these references.

Further, the Office Action does not designate any location in Yuen in which the elements of the claim are taught or disclosed. Again, only a generalized comment is made, the Office Action stating that "Yuen discloses the claimed invention including the use of made to order integrated circuits ("ICs")." Therefore, the Office Action also does not comply with 37 CFR 1.104(c)(2) with regard to Yuen.

Applicant respectfully requests that any further rejection include the designations as required by 37 CFR 1.104(c)(2).

In spite of the lack of information provided in regard to the reasons for the present rejection, it is clear that Yuen does not teach the steps of Claim 11 as claimed. In other words, Yuen does not "disclose the claimed invention" as stated in the Office Action. The claimed invention does not constitute simply "the use of made to order integrated circuits", which is the only guidance provided in the Office Action with respect to Yuen. Claim 11 recites:

11. A computer controlled method for processing an order for programmable integrated circuits (ICs), comprising the steps of:  
    receiving a plurality of configurations from a plurality of customers  
    by a vendor of the programmable integrated circuits;  
    storing the plurality of configurations, the storing being performed  
    by the vendor;

pulling specified volumes of un-programmed ICs from inventory by the vendor in response to an order from a first customer of the plurality of customers;

programming the specified volumes of ICs by the vendor with one of the plurality of configurations selected by the first customer; and

packing the programmed ICs for shipment from the vendor to the first customer.

Yuen neither teaches nor discloses the steps of receiving, storing, pulling, programming, and packing, as claimed in Claim 11. As far as is apparent to Applicant, neither Green nor Dobler remedies these deficiencies.

The Office Action states:

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yuen to include a modern inventory control process as described in both Greene and Dobler. Such a modification would have implemented a modern inventory solution to the custom ICs.

Note that the Office Action does not suggest, much less prove, that either Greene or Dobler teaches or suggests the steps of Claim 11 as part of "a modern inventory control process". Further, the Office Action fails to show that the combination of Yuen with either Greene or Dobler would yield the series of steps recited in Claim 11.

Further, addressing the "rigorous ... requirement for a showing of the teaching or motivation to combine prior art references," the Court of Appeals for the Federal Circuit has stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, (citations omitted), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The Office Action does not include a "clear and particular" showing of the claimed steps, much less a "clear and particular" showing of a suggestion to combine these steps. The only motivation given is a "broad conclusory statement", e.g., "[b]y using modern inventory control practices such as resource planning with precise inventory tracking, the manufacturer can reduce costs and thereby increase profit." Please note that combining the teachings of Yuen with "resource planning with precise inventory tracking" does not yield the steps recited in Claim 11.

Therefore, and for at least these reasons, Claim 11 is allowable over Yuen, Greene, and Dobler, taking alone or in combination. Claims 12-23 are also allowable for at least the reasons of Claim 11, from which they depend.

Claims 29-42 are rejected as being unpatentable over Powell et al. (U.S. Patent No. 6,657,426). Claims 29-42 are cancelled. Therefore, this rejection is moot.

#### Request for a Non-Final Action

If an action other than allowance of the pending claims is to be made, Applicant respectfully requests that the next action be a non-final action. The outstanding Office Action is not in compliance with 37 CFR 1.104(c)(2), which states:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The particular parts of the reference relied on in the outstanding rejections should be explained, because well over 1200 pages of references have been cited (with one reference being over 900 pages), with no attempt being made to identify the particular parts being relied on.

Further, Claims 11-23 include many specific limitations that are not addressed in the Office Action. For example, Claim 11 recites "receiving a plurality of configurations from a plurality of customers"; "storing the plurality of configurations", "pulling specified volumes of un-programmed ICs from inventory", "programming the

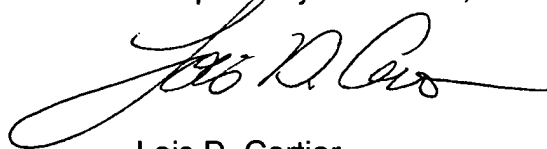
specified volumes of ICs", and "packing the programmed ICs for shipment", none of which limitations are specifically addressed in the Office Action. Claim 12 recites "attaching a memory device to the FPGAs"; Claims 13 and 14 recite "programming the memory device while it is connected to the FPGA", Claims 15-18 recite different types of the memory devices attached to the FPGA; Claim 19 recites "testing the programmed ICs"; Claim 20 recites "labeling the programmed ICs to reflect the selected configuration"; Claim 21 recites "tracking sales of the volumes of ICs programmed using the specific configuration"; Claim 22 recites that "the selected configuration is developed by the customer"; and Claim 23 recites that "the step of labeling comprises marking the programmed ICs with at least one of a customer name and a customer logo". The Office Action fails to cite any teachings of Yuen, Greene, or Dobler as corresponding to these limitations, and no readily apparent teachings of any of these references appear to suggest these limitations.

Therefore, Applicant respectfully requests that any further rejection be a non-final action.

### CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patent, P.O. Box 1450, Alexandria, Virginia 22313-1450, on January 11, 2006.

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Signature